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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,697	01/27/2004	Robert Frederick	120137.481	2064
500 7590 08/03/2007 SEED INTELLECTUAL PROPERTY LAW GROUP PLLC 701 FIFTH AVE SUITE 5400 SEATTLE, WA 98104			EXAMINER SHAH, AMEE A	
			ART UNIT 3625	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/766,697	<b>Applicant(s)</b> FREDERICK ET AL.	
	<b>Examiner</b> Amea A. Shah	<b>Art Unit</b> 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 May 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-93 is/are pending in the application.
- 4a) Of the above claim(s) 1-15, 17-20, 22, 23, 25-27 and 29-84 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16, 21, 24, 28 and 85-92 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 May 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                           | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

### **DETAILED ACTION**

Claims 16, 21, 24, 28 and 85-93 are examined in this action.

#### ***Claim Rejections - 35 U.S.C. § 101***

35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 87 is rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Claim 87 is directed to a computer readable medium as a data transmission medium transmitting a generated data signal. Since signals are merely energy, they are nonstatutory natural phenomena. *See O'Reilly v. Morse*, 56 U.S. (15 How.) 62 at 112-14 (1853). Moreover, a signal encoded with functional descriptive material does not fall within any of the categories of patentable subject matter set forth in §101. It is not a process, because it is not a series of steps. The other three classes of §101, i.e. machine, and compositions of matter and manufactures, have traditionally required physical structure or material. Thus, a claim directed to a signal is directed to non-statutory subject matter under §101. Claim 87 will not further examined with respect to applicability of prior art.

#### ***Claim Rejections - 35 U.S.C. § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the

applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 16, 21, 24, 28, 85, 86 and 88-93 are rejected under 35 U.S.C. §102(e) as being anticipated by Hazzard et al., US 2005/0125389 A1 (hereafter referred to as “Hazzard”).**

Referring to claim 16. Hazzard discloses a computer-implemented method for selling access to Web services to Web service consumers who are unrelated to Web service providers who provide those Web services (*see, e.g.,* Abstract), the method comprising:

- in response to registration requests from providers of Web services, registering Web services so as to make access to those Web services available for purchase by unrelated consumers of Web services, the registered Web services each having at least one associated use price (¶¶0021, 0022 and 0044 – note that the associated use prices are the payment terms);
- providing information about the available registered Web services to consumers of Web services (¶¶0022, 0027 and 0045);
- in response to each of multiple access requests from the consumers, performing a sale to a consumer for access to an indicated one of the registered Web services in exchange for an access fee from the consumer that is based on a use price associated with the indicated Web service (¶¶0045 and 0046);
- after each of at least some sales to a consumer for access to a registered Web service, providing to the consumer access to the registered Web service by invoking that Web service from the provider of the Web service on behalf of the consumer and by providing response

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information from the invoking to the consumer (§§0017, 0019, 0020, 0023, 0025, 0037 and 0045); and

- providing payment for each of the registered Web services to the provider of that Web service based on the access fees paid by the consumers for access to that Web service (§§0017 and 0046).

Referring to claim 21. Hazzard further discloses the method of claim 16 wherein the received access requests and the corresponding performed access sales are each for an access subscription for a consumer to a registered Web service (§§0037 and 0045 – note that the method authenticates the user in the subscriber database after receiving an access request).

Referring to claims 24 and 28. Hazzard further discloses the method of claim 21 wherein each access subscription provides a specified multiple number of times that access may be provided, including a single immediate access to a registered Web service such that the providing of the access to the consumer occurs in response to the access request that produced the access subscription (§0046).

Referring to claims 85 and 91. All of the limitations in apparatus claims 85 and 91 are closely parallel to the limitations of method claim 16, analyzed above and are rejected on the same bases.

Referring to claims 86 and 88. Hazzard further discloses the computer-readable medium of claim 85 wherein the computer-readable medium is memory of a computing system and the contents are instructions that when executed cause the computing system to perform the method (¶0018 – note that the method can be performed by any logic on hardware or software).

Referring to claim 89. Hazzard further discloses the computer-readable medium of claim 85 wherein the contents include one or more data structures comprising multiple entries that each correspond to one of the available Web services that has been registered by the third-party provider from whom the Web service is available, at least some of the entries including at least one use price and at least one use condition (¶¶0018-0020 – note the data structures include the directory database of the brokerage module).

Referring to claim 90. Hazzard further discloses the computer-readable medium of claim 85 wherein the contents include one or more data structures comprising multiple entries that each correspond to a subscription purchased by a consumer to one of the registered Web services, each of the entries including criteria indicating whether an attempted use of the subscription for an access of the registered Web service is valid (¶¶0023 and 0031 – note the data structures include the repository and the security modules).

Referring to claims 92 and 93. All of the limitations in apparatus claims 92 and 93 are closely parallel to the limitations of apparatus claims 86 and 88, analyzed above and are rejected on the same bases.

***Response to Amendment***

Applicant's amendment, filed May 31, 2007, has been entered. In view of the amendments to the drawing and the specification, the objections to the drawings and the specification are withdrawn.

The declaration filed on May 31, 2007, under 37 CFR 1.131 has been considered but is ineffective to overcome the Hazzard reference.

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Hazzard reference to either a constructive reduction to practice or an actual reduction to practice. While the declaration of the inventors shows conception, the declaration of James White along with the documentary evidence is not sufficiently specific to show diligence because it does not provide actual dates of acts relied on to establish diligence. See MPEP §715.07(II) ("When alleging that conception or a reduction to practice occurred prior to the effective date of the reference, the dates in the oath or declaration may be the actual dates or, if the applicant or patent owner does not desire to disclose his or her actual dates, he or she may merely allege that the acts referred to occurred prior to a specified date. However, the actual dates of acts relied on to establish diligence must be provided. See MPEP § 715.07(a) regarding the diligence requirement.") See also MPEP §715.07(A).

***Response to Arguments***

Applicant's arguments filed May 31, 2007, have been fully considered but they are not persuasive. In response to applicant's arguments regarding claim 87 being statutory subject matter (Remarks, page 5), the Examiner disagrees and reasserts the Office's position, as

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discussed above, that data signals are merely energy and natural phenomena and therefore not statutory under 35 U.S.C. §101. Applicant's argument that each claim features and provides functionality not disclosed by Hazzard fails to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ameer A. Shah whose telephone number is 571-272-8116. The examiner can normally be reached on Mon.-Fri. 7:00 am - 3:30 pm.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogesh C. Garg can be reached on 571-272-6756. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AAS

July 30, 2007

  
YOGESH C. GARG  
PRIMARY EXAMINER  
TECHNOLOGY CENTER 3600